

Commissioner for Patents
July 18, 2005
Page 6 of 12

Serial No. 10/733,841
Art Unit: 3661 Examiner: Cuong H. Nguyen
IBM Docket No.: AUS920031011US1(4032)

REMARKS

Claims 1-21 are pending and claims 1-21 stand rejected. In a previous Office action mailed November 16, 2004, the Office action rejected claims 1-5 and 7-24 under 35 USC § 102(e) as being anticipated by Whitman U.S. Pat. 6,526,351 (hereinafter "Whitman") and further rejected claim 6 under 35 USC § 103(a) as being unpatentable over Whitman in view of Bodin U.S. Pat. 6,813,559 (hereinafter "Bodin"). In a Response dated February 15, 2005, Applicant amended independent claims 1, 11 and 19 solely to provide further clarification of the invention and requested reconsideration of the rejections.

In the present final Office action mailed May 18, 2005, the Office action rejected claims 22 and 24 under 35 USC § 102(e) as being anticipated by Whitman. The Office action further rejected claims 1-5, 7-21, and 23 under 35 USC § 103(a) as being unpatentable over Whitham in view of Trossen U.S. Pat. Application Publication US 2005/0059410 A1 (hereinafter "Trossen"). The Office action further rejected claim 6 under 35 USC § 103(a) as being unpatentable over Whitham in view of Trossen and further in view of Bodin. Applicants have cancelled claims 22-24, making the Office action rejection of those claims now moot.

Applicants have submitted a declaration under 37 C.F.R. § 131 with this Response establishing the invention of the subject matter of the rejected claims as on or before August 22, 2003. Applicants respectfully contend that they have successfully "sworn behind" the Trossen reference as its effective filing date is September 17, 2003. Applicants respectfully believe that the rejections have been traversed in light of the following remarks. All of the pending claims in the present application are believed to be patentable over any combination of these references and the Examiner's reconsideration is respectfully requested.

Claim rejections under 35 USC § 103(a)

Claims 1-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Whitman in view of Trossen (and Bodin for claim 6). As conceded by the Office action, Whitman does not disclose each and every element of claims 1-21, including receiving differential information from a user at a current location and providing a location-based service based on a particular

Commissioner for Patents
July 18, 2005
Page 7 of 12

Serial No. 10/733,841
Art Unit: 3661 Examiner: Cuong H. Nguyen
IBM Docket No.: AUS920031011US1(4032)

location. As Applicants' declaration under 37 C.F.R. § 131 eliminates Trossen as prior art to the present patent application, claims 1-21 are patentable as none of the disclosed and applicable references, alone or in combination, disclose the limitations of the claims, and Applicants respectfully request that the rejections be removed and the claims allowed. As will be described subsequently, even if Trossen were a valid prior art reference, claims 1-21 are patentable.

To establish a prima facie case of obviousness, three basic criteria must be met.¹ First, there must be a suggestion or motivation to modify or combine the references.² Second, there must be a reasonable expectation of success in the modification or combination.³ Finally, the modification or combination must teach or suggest all of Applicants' claim limitations.⁴

Claims 1-5, 7-10

In regards to independent claim 1, the Office action fails to establish a prima facie case of obviousness by Whitman in view of Trossen because citations of Whitman and Trossen provided as support for the rejections fail to describe, suggest or teach "each and every element as set forth in the claim[s]". In particular, amended claim 1 states:

receiving from a user at a current location differential information, the differential information indicating a difference between the current location and a particular, different location....

Whitman, in contrast, does not disclose or suggest receiving *from a user* at a current location differential information. Whitman teaches an interactive multimedia guide "that is implemented using a GPS (Global Positioning System) system enabled map program with a GIS (Geographic Information System) database running on a computer" (Specification, column 2, lines 52-55). Whitman provides that the disclosed system may display a map of a selected tour and the location of the GPS receiver and user on the map (Specification, column 4, lines 24-27). Whitman further provides that during a tour the system may provide to the user audible directions to a different destination while en route to a first destination (Specification, column 4, lines 27-29). While Whitman does teach an interactive multimedia guide system providing directions between a user's current location and another location, Whitman does not disclose or

¹ Manual of Patent Examining Procedure §2142.

² *In re Vaack*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

³ *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986).

Commissioner for Patents
July 18, 2005
Page 8 of 12

Serial No. 10/733,841
Art Unit: 3661 Examiner: Cuong H. Nguyen
IBM Docket No.: AUS920031011US1(4032)

suggest receiving differential information *from a user* and is thus readily distinguishable from the present invention. Whitman, in contrast, discloses providing directions *to a user* from a user's current location to another location specified in the tour guide. Whitman simply does not teach or suggest, expressly or inherently, the teachings of independent claim 1. Whitman, in fact, teaches away from the teachings of amended independent claim as a user of Whitman's interactive multimedia guide who needs to receive directions to a location certainly would not be in a position to provide directional information to the interactive multimedia guide.

Neither does Trossen disclose receiving *from a user* at a current location differential information. Trossen instead discloses "a service provider that can receive a request for a differential location service from the terminal at least partially over a wireless network" and a service provider that can provide a "requested differential location service" to a terminal (Abstract). Trossen thus does not disclose receiving differential information from a user and instead discloses receiving a request for a differential location service *from the terminal* and a differential location service *from the service provider*. Neither Whitman nor Trossen disclose or suggest receiving differential information *from a user*.

Whitman also fails to disclose or suggest "providing a location-based service, wherein the location-based service produces results that are at least partially based on the particular location", particularly when the particular location is determined based on "the differential information received from the user" as taught by claim 1. Whitman teaches providing a location-based service based on the *current* location of the user (Specification, column 4, lines 39-55; *see also*, Specification, column 5, lines 25-45). For example, Whitman discloses providing restaurant recommendations that are "reasonably close" to the user's current location or "in the vicinity" of the user (Specification, column 5, lines 25-45). Whitman also teaches a service with "primary destinations in a given tour" and "ancillary points of interest" of a pre-defined tour (Specification, column 3, lines 20-42). The ancillary points of interest taught by Whitman are the *results* of a location-based service and not the *basis* for one and thus are not a "particular location" as defined in claim 1. The ancillary points of interest are predefined for a tour and not the result of a determination made in response to "differential information received from a user",

⁴ *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

Commissioner for Patents
July 18, 2005
Page 9 of 12

Serial No. 10/733,841
Art Unit: 3661 Examiner: Cuong H. Nguyen
IBM Docket No.: AUS920031011US1(4032)

as required by claim 1. Whitman simply does not disclose or suggest providing a location-based service, wherein the location-based service produces results that are at least partially based on the particular location, and where the particular location is determined based on the differential information received from the user.

Trossen also fails to disclose or suggest "providing a location-based service, wherein the location-based service produces results that are at least partially based on the particular location", particularly when the particular location is determined based on "the differential information received from the user" as taught by claim 1. Trossen instead discloses providing "the requested differential location service based upon a comparison of a current location of the terminal and the geographic area defined in the predetermined manner." (Abstract) The mapping processor of Trossen "can receive the geographic area from the service provider" and "transform the geographic area of the request to thereby define the geographic area in a predetermined manner" (Abstract). Trossen provides a service based on a current location and an area defined by a mapping processor and does not disclose or suggest providing a location-based service based on a particular location where the particular location is determined based on *differential information received from a user*.

Whitman and Trossen do not teach or suggest, alone or in combination, multiple limitations of claim 1 for the reasons described above as well as other reasons. Accordingly, Applicant respectfully requests that the rejection of claim 1 be withdrawn and that claim 1 be allowed. Further, claims 2-5 and 7-10, being dependent upon claim 1, incorporate the limitations of claim 1. Applicant therefore respectfully requests that these rejections be withdrawn and claims 2-5 and 7-10 be allowed. The Office action's individual rejections of particular dependent claims are now moot in light of the arguments presented above and need not be addressed.

Claims 19-21

In addition, neither Whitman nor Trossen teach or suggest, alone or in combination, multiple limitations of amended claim 19 for the reasons described above for claim 1 as well as other reasons. Further, claims 20-21, being dependent upon claim 19, incorporate the limitations of claim 19. Accordingly, Applicant respectfully requests that the rejection of claims 19-21 be withdrawn and that claims 19-21 be allowed.

Commissioner for Patents
July 18, 2005
Page 10 of 12

Serial No. 10/733,841
Art Unit: 3661 Examiner: Cuong H. Nguyen
IBM Docket No.: AUS920031011US1(4032)

Claims 11-18

Similarly, neither Whitman nor Trossen teach or suggest, alone or in combination, all of the limitations of amended independent claim 11 for the reasons as described previously regarding claim 1, among other reasons. In particular, Whitman does not teach or suggest "a user interface for receiving user input, wherein the user input comprises differential information", as taught by independent claim 11, as the interactive multimedia guide of Whitman does not provide receiving differential information *from a user*, instead only teaching displaying directions to an ancillary location to the user (Specification, column 3, lines 20-42). Neither does Whitman disclose or suggest a "service module providing a location-based service based on the particular location" as taught by independent claim 11. As described previously, Whitman teaches providing information based on the *current* location of the user (Specification, column 4, lines 39-55; *see also*, Specification, column 5, lines 25-45) and does not disclose or suggest providing a location-based service based on a particular, different location.

Similarly, Trossen does not teach or suggest "a user interface for receiving user input, wherein the user input comprises differential information" as the user of a terminal of Trossen does not provide differential information, as the service provider receives a request for a differential location service from the terminal, not the user. (Abstract) Trossen also does not disclose or suggest a "service module providing a location-based service based on the particular location" as taught by independent claim 11 as the service provider and mapping processor of Trossen provide a service based on the current location and a pre-determined geographic area (Abstract), not on the particular location as defined in claim 11 that is based on differential information received from a user.

Neither Whitman nor Trossen teach or suggest, alone or in combination, multiple limitations of amended claim 11 for the reasons described above and other reasons. Accordingly, Applicant respectfully requests that the rejection of claim 11 be withdrawn and that claim 11 be allowed. Further, claims 12-18, being dependent upon claim 11, incorporate the limitations of claim 11. Applicant therefore respectfully requests that these rejections be withdrawn and claims 12-18 be allowed.

Commissioner for Patents
July 18, 2005
Page 11 of 12

Serial No. 10/733,841
Art Unit: 3661 Examiner: Cuong H. Nguyen
IBM Docket No.: AUS920031011US1(4032)

Claim 6

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Whitman in view of Trossen and further in view of Bodin. As conceded by the Office action, Whitman and Trossen do not disclose "wherein the differential information comprises an indication of height", an element of dependent claim 6. Claim 6 is dependent upon independent claim 1 and incorporates the limitations of claim 1. Independent claim 1 is patentable because, as described previously, none of the disclosed references, alone or in combination, disclose the limitations of amended independent claim 1. Claim 6 is thus also patentable and the Applicant respectfully requests that the rejection being removed and claim 6 allowed. Claim 6 is also patentable as it would not be obvious to combine Bodin with either Whitman or Trossen. Bodin discloses a position of an unmanned aerial vehicle (UAV) being expressed in a height or altitude in an invention relating to orbiting a waypoint for a UAV. There is no suggestion or motivation in either Whitman or Trossen to modify or combine the teachings of Bodin with those references. Applicant respectfully requests that the rejection of claim 6 be withdrawn and that claim 6 be allowed.

Commissioner for Patents
July 18, 2005
Page 12 of 12

Serial No. 10/733,841
Art Unit: 3661 Examiner: Cuong H. Nguyen
IBM Docket No.: AUS920031011US1(4032)

CONCLUSION

In the present response, Applicants responded to the Office action's claim rejections under 35 USC §§ 102 and 103. Accordingly, Applicant believes that this response constitutes a complete response to each of the issues raised in the office action. Applicants believe that the pending claims are in condition for allowance and, accordingly, Applicants request that the rejections be withdrawn, pending claims be allowed, and application advance toward issuance. If the Examiner has any questions, comments, or suggestions, the undersigned attorney would welcome and encourage a telephone conference at (860) 643-0102.

Respectfully submitted,

July 18, 2005
Date

James L. Nickelson
James L. Nickelson, Reg. No. 46,140
Customer No.: 45557
Schubert Osterrieder & Nickelson PLLC
6013 Cannon Mtn. Dr, S14
Austin, Texas 78749
(512) 692-7297 (Telephone)
(512) 301-7301 (Facsimile)
Attorney for Applicant(s)